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10/652,253	09/02/2003	Jonas Hafren	060279.00061	1859

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EXAMINER

PHUONG, DAI

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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01/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/652,253

Applicant(s)

HAFREN, JONAS

Examiner

Dai A. Phuong

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-34, 36 and 38-47 is/are rejected.
- 7) ☒ Claim(s) 14 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments, filed 10/29/2007, with respect to claims have been considered but are not persuasive. Claim 35 had been canceled. Claims 1-34 and 36-47 are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6 and 15-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al. (Pub. No: 20030093545).

Regarding claim 1, Liu et al. disclose a method comprising:

establishing a mobile packet data connection for a subscriber (fig. 1, [0015]);

establishing, over said established mobile packet data connection, a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source (fig. 1, [0015] to [0016]);

terminating the streaming connection between said subscriber and said streaming source (fig. 1, [0037] to [0044]);

measuring a duration of said continuous media stream (fig. 1, [0037] to [0044]); and

charging said streaming connection based on said measured duration of said continuous media stream (fig. 1, [0037] to [0044]). It is inherent that the system includes a timer which is able to recognize a start and an end of downloading e-book for charging communication time of downloading).

Regarding claim 2, Liu et al. disclose all the limitations in claim 1. Further, Liu et al. disclose the method wherein said charging further comprises: generating charging information based on the said duration (fig. 1, [0037] to [0044]).

Regarding claim 3, Liu et al. disclose all the limitations in claim 1. Further, Liu et al. disclose the method wherein said step of measuring said duration of said continuous media stream further comprises: identifying a start and an end of said continuous media stream based on a change of a state of said continuous media stream (fig. 1, [0037] to [0044]).

Regarding claim 4, Liu et al. disclose all the limitations in claim 1. Further, Liu et al. disclose the method wherein said step of measuring the duration of said continuous media stream further comprises: recognizing a start of said continuous media stream (fig. 1, [0037] to [0044]); starting a timer for measuring the length of said continuous media stream (fig. 1, [0037] to [0044]); recognizing an end of said continuous media stream (fig. 1, [0037] to [0044]); stopping said timer for measuring the duration of said continuous media stream (fig. 1, [0037] to [0044]); and obtaining the length of said continuous media stream from said time (fig. 1, [0037] to [0044]).

Regarding claim 6, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method wherein said recognizing the end of said continuous media stream further

comprises the recognizing a streaming protocol teardown message and signaling said end of said continuous media stream (fig. 1, [0037] to [0044]).

Regarding claim 15, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method wherein the method further comprising: checking whether a continuous media stream for the subscriber can be established (fig. 1, [0037] to [0044]).

Regarding claim 16, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method wherein the method further comprising: checking whether said duration based charging can be used for said subscriber for continuous media stream (fig. 1, [0037] to [0044]).

Regarding claim 17, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method wherein the method further comprising: checking whether said duration based charging can be used for said subscriber for said continuous media (fig. 1, [0037] to [0044]).

Regarding claim 18, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method wherein said checking is performed based on at least one of a Mobile Subscriber International Mobile Station Identifier number, an International Mobile Subscriber Identity number, a client number, an identifier number, and a subscriber identifier (fig. 1, [0037] to [0044]).

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 18.

Regarding claim 20, this claim is rejected for the same reason as set forth in claim 18.

Regarding claim 21, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method wherein the method further comprising: storing said duration of said continuous media stream in one or several charging records (fig. 1, [0037] to [0044]).

Regarding claim 22, this claim is rejected for the same reason as set forth in claim 21.

Regarding claim 23, Liu et al. disclose all the limitations in claim 4. Further, Liu et al. disclose the method further comprising: generating a charging record comprising said duration of said continuous media stream in relation to said subscriber (fig. 1, [0037] to [0044]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (Pub. No: 20030093545) in view of Kinno et al. (Pub. No: 20060048669)

Regarding claim 7, Liu et al. disclose all the limitations in claim 1. However, Liu et al. do not disclose generating time stamps based on messages sent by said subscriber, and based on said time stamps, calculating said duration of said continuous media stream.

In the same field of endeavor, Kinno et al. generating time stamps based on messages sent by said subscriber, and based on said time stamps, calculating said duration of said continuous media stream ([0009] to [0016]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for downloading data to portable electronic device by specifically including generating time stamps based on messages sent by said subscriber, and based on said time stamps, calculating said duration of said continuous media stream, as taught by Kinno et al., the motivation being in order to control the media and delivery information more accurate.

Regarding claim 8, the combination of Liu et al. and Kinno et al. disclose all the limitations in claim 7. Further, Kinno et al. disclose the method wherein the method further comprises: recognizing a start of said continuous media stream ([0009] to [0016]); creating a first time stamp indicating a start time of said continuous media stream ([0009] to [0016]); recognizing an end of said continuous media stream; creating a second time stamp indicating the end of said continuous media stream ([0009] to [0016]); and calculating said length of said continuous media stream based on said first and said second time stamps ([0009] to [0016]).

Regarding claim 10, this claim is rejected for the same reason as set forth in claim 6.

6. Claims 11-13, 24-34, 36 and 38-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (Pub. No: 20030093545) in view of Masuda (Pub. No: 20030078031).

Regarding claim 11, Liu et al. disclose all the limitations in claim 1. Liu et al. disclose all the limitations in claim 1. However, Liu et al. do not disclose the method wherein said measuring the duration of said continuous media stream further comprises a step of: identifying a temporary stop of said continuous media stream based on a change of a state of said continuous media stream.

In the same field of endeavor, Masuda identifying a temporary stop of said continuous media stream based on a change of a state of said continuous media stream ([0110] to [0130]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for downloading data to portable electronic device by specifically identifying a temporary stop of said continuous media stream based on a change of a state of said continuous media stream, as taught by Masuda, the motivation being in order to delivery packets without the need to again retrieve the packets.

Regarding claim 12, the combination of Liu et al. and Masuda disclose all the limitations in claim 11. Further, Masuda discloses the method wherein said identifying a temporary stop of said continuous media stream is based on identifying a temporary stop ([0110] to [0130]).

Regarding claim 13, the combination of Liu et al. and Masuda disclose all the limitations in claim 11. Further, Masuda discloses the method wherein said identifying a streaming protocol said temporary stop of said continuous media stream ([0110] to [0130]).

Regarding claim 24, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 25, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 26, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 27, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 28, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 29, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 30, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 31, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 32, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 33, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 34, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 36, this claim is rejected for the same reason as set forth in claim 13.

Regarding claim 38, this claim is rejected for the same reason as set forth in claim 15.

Regarding claim 39, this claim is rejected for the same reason as set forth in claim 16.

Regarding claim 40, this claim is rejected for the same reason as set forth in claim 17.

Regarding claim 41, this claim is rejected for the same reason as set forth in claim 18.

Regarding claim 42, this claim is rejected for the same reason as set forth in claim 19.

Regarding claim 43, this claim is rejected for the same reason as set forth in claim 20.

Regarding claim 44, this claim is rejected for the same reason as set forth in claim 21.

Regarding claim 45, this claim is rejected for the same reason as set forth in claim 22.

Regarding claim 46, this claim is rejected for the same reason as set forth in claim 23.

Regarding claim 47, this claim is rejected for the same reason as set forth in claim 1.

7. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (Pub. No: 20030093545) in view of Cox et al. (Pub. No: 20030216145).

Regarding claim 5, Liu et al. disclose all the limitation in claim 4. However, Liu et al. do not disclose the method wherein said recognizing said start further comprises recognizing a streaming protocol play message signaling said start of said continuous media stream.

In the same field of endeavor, Cox et al. disclose the method wherein said recognizing said start further comprises recognizing a streaming protocol play message signaling said start of said continuous media stream ([0056] and [0062])

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication system of combination of Liu et al. by specifically including disclose the method wherein said recognizing said start further comprises recognizing a streaming protocol play message signaling said start of said continuous media stream, as taught by Cox et al., the motivation being in order to provide low cost; and also provide the wireless carrier useful information about its customers' calling patterns, which may affect decisions relating to system expansion.

Regarding claim 9, this claim is rejected for the same reason as set forth in claim 5.

Allowable Subject Matter

8. Claims 14 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 14, the prior art record does not disclose nor fairly suggest the method wherein said measuring the duration of said continuous media stream further comprises the steps of: sending temporary stop information about a temporary stop of said continuous media stream; based on said temporary stop information, halting temporarily the measuring of said length of said continuous media stream; sending restart information about a restart of said continuous media stream; based on said restart information, restarting the measuring of said duration of said

continuous media stream; and measuring the duration of said continuous media stream based on said temporarily halting and restarting of the measuring of said duration of said continuous media stream.

Regarding claim 37, the prior art record does not disclose nor fairly suggest mobile packet radio system, wherein said measurement unit is configured to indicate a temporary break of said duration of said continuous media stream in response to temporary stop information about said temporary stop, to continue the measurement of said duration of said continuous media stream in response to restart information about a restart, and to measure the duration of said continuous media stream based on said indication of the temporary break and said restart of the measurement of the duration of said media stream.

Response to Argument

Applicant, on page 4 of the remark, argues that Claim 1 recites, in part, "establishing, over said established mobile packet data connection, a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source." Liu fails to disclose or suggest at least this feature of claim 1. The Office Action took the position that this feature is disclosed by Liu in Figure 1 and at paragraphs [0015] and [0016]. The cited passages, however, make no mention of establishing "a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," as recited in claim 1. Indeed, as can be seen from the discussion above, Liu fails to teach or suggest a streaming connection comprising a continuous media stream configured for real-time playback. Rather, Liu merely discloses an e-book file

download that is non-streaming and not configured for real-time playback. Since all the divisions of the e-book file must be downloaded and decoded before the e-book file can be displayed, the playback of the e-book is non-real-time. Consequently, the connection on which the e-book file is being downloaded is non-streaming. However, the Examiner respectfully disagrees.

First, Liu discloses in Figure. 1, paragraph 36 to paragraph 44 a method for downloading data to a portable electronic device of the invention in the use of a cellular phone 11 for a terminal user 1 to login a service management center 3; wherein downloaded data can be other information such as pictures, images, sounds and so on (see paragraph 16). Thus, e-book is also a type of video. In paragraph 37, Liu discloses that the terminal user (subscriber) uses the cellular phone requests to establish a connection to the streaming source (the service management center) via the network communication system 2. The network communication system includes a network system, e.g., a wireless network equipped with multiple signal reception stations, internet (thus, it is inherent that the connection is for mobile packet data). Once the connection is established, the terminal user submits a downloading request to the streaming source (the service management center). After receiving the downloading request, the streaming source (the service management center) retrieves the downloaded data from the database and transmits to the cellular phone. When the cellular phone receives the download data and displays the download data on the display to the terminal user. The Applicant should be noted that “encoded” and “decoded” steps are the way to process data, which avoid or prevent unauthorized retrieves data. Therefore, “encoded” and “decoded” steps do not cause the download data to be non-streaming as asserted by the Applicant. In addition, “encoded” and “decoded” steps are well known in the art for transmitting and receiving.

Second, in response to applicant's argument that the Office Action took the position that this feature is disclosed by Liu in Figure 1 and at paragraphs [0015] and [0016]. The cited passages, however, make no mention of establishing "a streaming connection comprising a continuous media stream configured for real-time playback between said subscriber and a streaming source," as recited in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant, on page 5 of the remark, argues that Claim 1 also recites, "establishing a mobile packet data connection for a subscriber." Liu further fails to disclose or suggest at least this feature of claim 1, because Liu merely discloses using a WAP cellular phone. However, the Examiner respectfully disagrees.

In response to Applicant's argument, Liu discloses in Figure. 1, paragraph 37, Liu discloses that the terminal user (subscriber) uses the cellular phone requests to establish a connection to the streaming source (the service management center) via the network communication system 2. The network communication system includes a network system, e.g., a wireless network equipped with multiple signal reception stations, internet (thus, it is inherent that the connection is mobile packet data). It should be noted that for data service, a cellular phone is connected to a internet network, and for voice service, the cellular phone is connected to a mobile switching center (MSC) and a public switching telephone network (PSTN). In this case, the cellular phone is connected to the network communication system 2. The network

communication system includes a network system, e.g., a wireless network equipped with multiple signal reception stations, internet. Thus, it is inherent that the connection is for mobile packet data.

Applicant, on pages 7-8 of the remark, argues that Kinno was only cited for the purpose of features in the dependent claims related to time stamps. Accordingly, it is unsurprising that Kinno fails to remedy Liu's deficiencies with respect to independent claim 1. Furthermore, it would not have been obvious to include either a real-time playback feature or a streaming connection in Liu, because of the media that Liu is seeking to provide. Liu is seeking to provide e-books, but one of ordinary skill in the art would have seen no reason to provide e-books on a "real-time" basis, as one of ordinary skill in the art would have tended to view e-books as having essentially static and non-time-sensitive content. Accordingly, even if other art existed (not admitted) that would teach the features of claim 1 that Liu does not, one of ordinary skill in the art would not have found motivation to use such features in combination with the features of Liu, because there would not have been any expected anticipation that the results of adding the complexity of real-time stream capabilities would have been beneficial to readers of e-books, the main thrust of Liu's concern. Thus, it is respectfully submitted that the combination of Liu and Kinno fails to disclose or suggest all of the elements of any of claims 7-8 and 10, and it is respectfully requested that the rejection of claims 7-8 and 10 be withdrawn.

Additionally, in view of Kinno's filing date of August 25, 2005, Applicant respectfully asserts that Kinno as *U.S. Patent Application Publication No. 2006/0048669, published March 9, 2006*, is not proper prior art under 35 U.S.C. 102(e) (or any other section) because it was both

filed and published after the filing date of the present application. Applicant notes that Kinno is related to U.S. Patent Application No. 10/359,662, which apparently was filed on February 7, 2003, shortly before the filing and current priority date of the present application. For this additional reason, it is respectfully requested that the rejection be withdrawn. However, The Examiner respectfully disagrees.

First, in response to applicant's argument that Kinno was only cited for the purpose of features in the dependent claims related to time stamps. Accordingly, it is unsurprising that Kinno fails to remedy Liu's deficiencies with respect to independent claim 1, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, in response to Applicant's argument that Kinno *as U.S. Patent Application Publication No. 2006/0048669, published March 9, 2006*, is not proper prior art under 35 U.S.C. 102(e) (or any other section) because it was both filed and published after the filing date of the present application. The Examiner rejected claims 7-8 and 10 under **35 USC § 103, not 35 USC § 102 (e) as asserted by the Applicant**. For that reason, the Examiner concedes that the rejection is proper.

Fourth, in response to Applicant's argument that Applicant notes that Kinno is related to U.S. Patent Application No. 10/359,662, which apparently was filed on February 7, 2003, shortly before the filing and current priority date of the present application. The present application, 10/652253, filed on 09/02/2003 and filed claims priority from Provisional Application 60483136 which filed on 06/03/2003. On the other hand, Kinno's application filed on 08/08/2005 which is a Divisional of Application 10/359662 which filed on 02/07/2003. For that reason, the Examiner concedes that the rejection is properly combined.

Applicant, on pages 8-9 of the remark, argues that at least some of the deficiencies of Liu with respect to claim 1 are discussed above. Independent claims 24 and 47 each have their own scope (which is highlighted by the fact that they have been rejected separately from claim 1), but each recite at least some features similar to those discussed above, with respect to claim 1 and for which Liu is deficient. Likewise, claims 11-13, 25-34, 36, and 38-46 depend from, and further limit, claims 1 and 24. Masuda fails to remedy the above-identified deficiencies of Liu, and consequently the combination of Liu and Masuda fails to disclose or suggest all of the elements of any of the presently pending claims. Masuda generally relates to a communication system. More specifically, Masuda discusses a communication system capable of conducting multiple pre-paid mobile telephone services at the same time for one user. Both because of this general nature of the disclosure, and because Masuda was only cited with respect to media stream control issues, it is unsurprising that Masuda fails to remedy the deficiencies of Liu, which are discussed at length above. Furthermore, as discussed above with respect to the alleged combination of Liu and Masuda, the same combinatorial issues exist with respect to any alleged combination of Liu and Masuda that would include real-time playback functionality or

media stream/streaming media features. Briefly, because Liu relates to e-books, there would be no reason or incentive to make Liu include any real-time playback (since e-books are not conventionally presented in real-time formats) or in streaming media (since e-books are not ordinarily particularly time sensitive). Thus, it is respectfully submitted that Masuda cannot remedy the deficiencies of Liu, and it is respectfully requested that the rejection of claims 11-13, 24-34, 36, and 38-47 be withdrawn. However, the Examiner respectfully disagrees.

In response to applicant's argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant, on pages 10 of the remark, argues that Claims 5 and 9 depend from and further limit claim 1. At least some of the deficiencies of Liu with respect to claim 1 are discussed above. Cox does not remedy the above-identified deficiencies of Liu, and consequently the combination of Cox and Liu fails to disclose or suggest all of the elements of any of the presently pending claims. Cox generally relates to a method of providing directional assistance to a telephone subscriber. More specifically, Cox generally aims to improve directory assistance by overcoming problems associated with directory assistance services. Cox

was cited only with respect to the further limitations of claims 5 and 9. Accordingly, it is unsurprising that Cox fails to remedy the above-identified deficiencies of Liu. Because Cox fails to remedy the above-identified deficiencies of Liu, the combination of Liu and Cox fails to disclose or suggest all of the elements of claims 5 and 9, and it is respectfully requested that the rejections of claims 5 and 9 be withdrawn.

In response to applicant's argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen M Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7503.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong
AU: 2617
Date: 01/09/08


DUC M. NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600